

### **REMARKS**

Claims 1 and 3-23 were pending at the time the Office Action was issued.

Claims 1, 3, 4, 11, 13, and 18-19, of which claims 1, 11, and 19 are independent claims, are currently amended.

No claims are presently canceled.

Thus, claims 1 and 3-23 are currently pending.

### **Summary of Interview**

Applicants and their undersigned representative thank the Examiner for agreeing to a telephonic interview to discuss the claims and the cited references. The Examiner was kind enough to review a proposed amendment and response prior to the telephonic interview. Applicant's representative is grateful to the Examiner for her time and her candor.

The Examiner and applicant's representative discussed the foregoing amendments to independent claims 1, 11, and 19. The Examiner agreed that the amendments presented would further the prosecution of the case and, at least would necessitate reconsideration of the grounds for rejection.

### **Claim Rejections under 35 U.S.C. § 112**

Claims 3 and 4 were rejected under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter because the claims depended from claim 2 which was previously canceled. Applicants' undersigned attorney humbly apologizes for this mistake, for which he alone is entirely responsible. Applicants' attorney thanks the Examiner for her

attention to detail in noting that these claims indeed should have been amended to depend from claim 1. Applicants have amended claims 3 and 4. Respectfully, applicants submit that the amendments resolve the rejections to claims 3 and 4 under 35 U.S.C. § 112.

**Claim Rejections under 35 U.S.C. § 103(a)**

Claims 1, 3, 4, 6-18, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of references including Ayers, “AbiWord’s Potential” (hereinafter “Ayers”); in view of Rohr, “RE: Styles Again” (hereinafter “Rohr”); W3C, “W3C Schema Part 0: Primer, W3C Recommendation,” May 2001 (hereinafter “XML Schema”); W3C “XML Schema Requirements,” (hereinafter “XML Requirements”); and U.S. Patent No. 6,209,124 B1 to Vermeire (hereinafter “Vermeire”). Applicants respectfully traverse the rejections. Independent claims 1, 11, and 19 are currently amended to clarify the distinctions between the claims and the cited references.

Claims 1, 11, and 19 are currently amended to recite a distinction between what these claims recite and what the Office Action asserts is taught by Ayers. Namely, the Office Action quotes Ayers for the proposition that “The most significant difference between AbiWord and nearly every other word processor available is the nature of the native file format. *An \*.abi file is written in XML* and thus is also in ASCII format; the files can be read by any text editor.” (Office Action, Numbered Section 5, Last Paragraph on Page 4 through First Paragraph on Page 5; emphasis added.) Respectfully, Ayers fails to teach all of the limitations the Office Action asserts. Amendments to claims 1, 11, and 19 clarify the distinction between claims 1, 11, and 19 and Ayers.

Claim 1 is patentable over the cited references for at least three reasons. Claim 1 as amended is reproduced below for the convenience of the Examiner:

1. (Currently Amended) A method for representing field structures in a markup language document, comprising:
  - inputting an application document that has been generated by a word-processing an-application that uses a file format that is specific to the application, wherein the file format is in a non-markup language format that is native to the application and the file format comprises unique properties for describing fields within the document, wherein the unique properties are defined by the application;
  - determining one or more unique properties corresponding to a field that relates to at least one section of the application document;
  - determining whether the field is a complex field or a simple field;
  - mapping the determined properties of the field into at least one of a markup language element, an attribute, and/or a value, wherein the field is designated with a simple field markup language element when the field is determined to be a simple field; and
  - storing the mapped properties of the field in the markup language document whereby applications different from the application can understand the mapped field properties stored in the markup language document.

First, with all respect, Ayers not only fails to teach or suggest “a word-processing application that uses a file format that is specific to the application” as the Office Action asserts, but teaches just the opposite. (See Office Action, Numbered Section 5, Last Paragraph on Page 4). As previously quoted, the Office Action quotes Ayers for the proposition that “An \*.abi file is written in XML and thus is also in ASCII format; the files can be read by any text editor.” (Office Action, Numbered Section 5, Last Paragraph on Page 4 through First Paragraph on Page 5, quoting Ayers Page 2, Fourth Paragraph). If the file format of Ayers can be read by any text editor, surely, this is not “a file format that is specific to the application” as recited by claim 1. In fact, Ayers teaches using a file format that is *not* specific to the application, and thus teaches the opposite of what claim 1 recites. The rejection of claim 1 predicated on Ayers thus should be withdrawn.

Second, the Office Action's reliance on Ayers as supporting the rejections ignores expressed limitations of the claims. The Office Action incorrectly relies on Ayers internal XML format as teaching the "format that is native to the application and the file format comprises unique properties for describing fields within the document," "the markup language document," and "mapping the determined properties of the style into at least one of a markup language element, an attribute, and a value." The Manual of Patent Examining Procedure is clear that the references cited in a rejection under 35 U.S.C. § 103(a) not only must teach all of the limitations of the rejected claim, but that "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (MPEP § 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); emphasis added). As the Office Action asserts, Ayers uses an internal XML format. As a result, Ayers cannot teach both a format native to the application and a markup language document, which are recited as separate elements in claim 1. Moreover, if Ayers stores data in an internal XML format, it would not be involved in "mapping the determined properties" of the internal format into a markup language document. To assert that Ayers teaches both a format native to the application and a markup language document, as well as mapping content from one to the other, ignores the expressed limitations of the claim. Ayers therefore cannot support the 35 U.S.C. § 103(a) of claim 1.

Third, to clarify the distinctions between claim 1 and Ayers, applicants have amended claim 1 to recite that "the file format that is specific to the application" includes "a non-markup language format." Again, Ayers teaches using a markup language format file as the native format of its application; claim 1 plainly recites a non-markup and thus different limitation.

Because Ayers fails to teach a non-markup language format, Ayers fails to teach the limitations of claim 1, and the rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 1.

Claim 11 also is patentable over the cited references for at least three reasons. Claim 11 as amended is reproduced below for the convenience of the Examiner:

11. (Currently Amended) A computer-readable medium for representing fields in a markup language document, comprising:  
inputting an application document that has been generated by a word-processing application that uses a non-markup language file format that is specific to the application;  
determining properties relating to one or more fields used within the application document, wherein the field comprises unique properties are defined by the application;  
determining whether the field is one of a complex field and a simple field;  
writing the properties into at least one of a markup language element, an attribute, and a value, wherein the field is designated with a simple field markup language element when the field is determined to be a simple field; and  
storing the properties in the markup language document such that the fields of the application document are substantially maintained when the markup language document is parsed by an application that is different from the application used to generate the application document.

First, Ayers teaches away from using a “file format that is specific to the application.” Again, the Office Action quotes Ayers for the proposition that “An \*.abi file is written in XML and thus is also in ASCII format; the files can be read by any text editor.” (See Office Action, Numbered Section 5, First Paragraph on Page 10, quoting Ayers, Page 2, Fourth Paragraph). Again, if the file format of Ayers can be read by any text editor, Ayers’ file format not only is not a “file format that is specific to the application” as recited by claim 11, but Ayers teaches away from using a file format specific to the application. The rejection based on Ayers thus should be withdrawn against claim 11.

Second, relying on Ayers as teaching multiple separately recited elements ignores expressed limitations of claim 11. Again, all of the words of the claims must be considered, and

the references must teach all of the expressed limitations. (See MPEP § 2143.03). Because Ayers teaches using an internal XML format, Ayers does not teach both a format specific to the application and a markup language document, which are recited as separate elements in claim 11. To assert that Ayers teaches both a format specific to the application and a markup language document ignores expressed limitations of claim 11. Ayers therefore cannot support the 35 U.S.C. § 103(a) of claim 11.

Third, to clarify the distinctions between claim 11 and Ayers, applicants have amended claim 1 to recite “a non-markup language file format that is specific to the application” As the Office Action asserts, Ayers expressly teaches using a markup language format file as the native format of its application, and even extols the virtues of its XML format. By contrast, claim 11 plainly recites a non-markup language format different from that expressly taught by Ayers. Ayers fails to teach a non-markup language format and fails to teach the limitations of claim 11, thus rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 11.

Claim 19 also is patentable over the cited references. Claim 19 as amended is reproduced below for the convenience of the Examiner:

19. (Currently Amended) A system for representing fields in a markup language document, comprising:  
an application that is configured to:  
input an application document that has been generated by a word-processing ~~an~~ application that uses a non-markup language file format that is specific to the application;  
determine properties relating to a field included in at least one section of the application document, wherein the field comprises unique properties are defined by the application;  
determine whether the field is one of a complex field and a simple field;  
map the properties into at least one of a markup language element, an attribute, and a value, wherein the field is designated with a simple field markup language element when the field is determined to be a simple field; and

store the properties in the markup language document; and  
a validation engine configured to validate the markup language document.

In rejecting claim 19, the Office Action reincorporates its rejections of claim 11. However, as previously stated, applications respectfully submit that the Office Action was incorrect to conclude claim 11 was not patentable over Ayers.

First, again, Ayers again teaches away from using a “file format that is specific to the application” because of Ayers’ reliance on using a native, XML file format that “can be read by any text editor.” (*See* Office Action, Numbered Section 5, First Paragraph on Page 10, quoting Ayers, Page 2, Fourth Paragraph). Once again, if the file format of Ayers can be read by any text editor, Ayers’ file format not only is not a “a file format that is specific to the application.” Moreover, Ayers teaches away from using a file format specific to the application. The rejection based on Ayers thus should be withdrawn against claim 19.

Second, as previously described at length, to assert that Ayers teaches both a “file format specific to the application” and a “markup language document,” as well as being configured to “map the properties” from one to the other ignores what the claim recites. The cited references must teach all the limitations and all the words of the claims must be considered. Accordingly, Ayers fails to teach the limitations of claim 19 as asserted by the Office Action, and the rejection must be withdrawn against claim 19.

Third, applicants have amended claim 19 to clarify the distinctions between claim 19 and Ayers. Claim 19 recites that the file format that is specific to the application is a “non-markup language” file format. Because claim 19 recites the opposite of what Ayers expressly teaches, the rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 19.

Claims 3-10, 12-18, and 20-23 depend from and apply additional limitations to the respective claims from which each depends. Accordingly, claims 3-10, 12-18, and 20-23 are patentable for at least the same reasons for which the respective independent claims are patentable. In the interest of reducing the number of issues for the Examiner to consider in this response, the foregoing discussion focuses on independent claims 1, 11, and 19. The patentability of each remaining dependent claim is not separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. As noted, a specific traverse of the rejection of each dependent claim is not required, because dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.



**CONCLUSION**

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.



Frank J. Bozzo

Registration No. 36,756

Direct Dial: 206.342.6294

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
206.342.6200

